

### **REMARKS**

Claims 1-28 appear in this application for the Examiner's review and consideration.

Claims 29-38 have been withdrawn without prejudice to Applicant's right to file one or more continuing applications directed to any subject matter not presently claimed.

#### **Rejection Over U.S. Publication No. 2004/0177531**

Claims 1-4 and 28 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2004/0177531 to DiBenedetto *et al.* ("DiBenedetto").

Applicant submits that DiBenedetto is not prior art to the claimed invention as defined under 35 U.S.C. § 102(e). In particular, the subject matter of the claims of the present application was conceived of prior to the effective date of the DiBenedetto reference. In particular, the subject matter of the present application was conceived prior to March 10, 2003. In support of this position, Applicant submits herewith the Declaration of Douglas K. Robinson, as well as supporting documentation. For example, Exhibit A of the Declaration includes pages from a laboratory notebook detailing the concept of a "smart shoe" that remains flexible when walking but senses torsional forces during a golf swing and stiffens the lateral midsole of the shoe for stability. It was also noted that the smart shoe would use piezoelectric technology. Thus, the laboratory notebook pages disclose the concept of a shoe that determines whether the wearer is walking or swinging, and when the wearer is swinging the shoe changes from an initial state, such as walking, where the shoe exhibits a first set of characteristics, such as flexibility, to a transitory state, such as swinging, where the shoe exhibits a second set of characteristics different from said first set of characteristics, such as lateral stiffness. Thus, Applicant submits that the DiBenedetto publication is not prior art under 35 U.S.C. § 102(e), and respectfully requests that the rejection be withdrawn.

Accordingly, independent claims 1 and 28 are believed to be in condition for allowance for at least the reasons set forth above. Moreover, dependent claims 2-4 depend from the claims discussed above and are patentable for at least the same reasons. As such, Applicant respectfully requests that the rejection under 35 U.S.C. § 102(e) be reconsidered and withdrawn.

**Rejection Over DiBenedetto In View of U.S. Patent No. 5,500,635**

Claims 7-16 were rejected under 35 U.S.C. § 103(a) as being obvious over DiBenedetto. Additionally, claims 17-21 were rejected as unpatentable over DiBenedetto in view of U.S. Patent No. 5,500,635 to Mott ("Mott").

As discussed above, Applicant submits that the DiBenedetto publication is not prior art under 35 U.S.C. §102(e). Therefore, the remaining reference, Mott, taken alone does not disclose, or even suggest, the present invention. More specifically, the reference does not disclose or suggest a shoe that determines whether the wearer is walking or swinging, and when the wearer is swinging the shoe changes from an initial state, such as walking, where the shoe exhibits a first set of characteristics, such as flexibility, to a transitory state, such as swinging, where the shoe exhibits a second set of characteristics different from said first set of characteristics, such as lateral stiffness. Thus, claims 7-21 and additionally claims 22-27 are patentable over the cited references.

The rejection under 35 U.S.C. § 103(a) is believed to have been overcome for at least the above reasons. Applicant respectfully requests reconsideration and withdrawal thereof.


**Conclusion**

Based on the remarks set forth above, Applicant believes that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicant's attorney would further the prosecution of this application, the Examiner is encouraged to call the attorney at the number below.

A Petition for Extension of Time is submitted herewith. A separate fee sheet is enclosed.  
Should any additional required fees be due, please charge them to Acushnet Company Deposit  
Account No. 502309.

Respectfully submitted,

2/12/07  
Date

  
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Attachments